

APPLICANT(S): DALTON, James T. et al.
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REMARKS

Claims 1-95 are pending in the application. Claims 1-20, 24-31, 35-37, 52-64, 68-75 and 79-81 have been rejected.

Claims 21-23, 32-34, 38-51, 65-67, 76-78 and 82-95 are withdrawn from consideration as being drawn to the non elected invention.

Applicants respectfully assert that the amendments to the claims add no new matter.

Double Patenting Rejections

In the Office Action, the Examiner rejected claims 1-20, 24-31, 35-37, 52-64, 68-75 and 79-81 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-85 of U.S Patent No. 6,838,484 or over claims 1-10 of U.S. Patent No. 6,569,896 or over claims 1-5 of U.S. Patent No. 6,492,554.

Applicants hereby offer to provide a terminal disclaimer upon indication by the Examiner of allowable claims.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1-20, 24-31, 35-37, 52-64, 68-75 and 79-81 under 35 U.S.C. § 103(a), as allegedly being rendered obvious in view of Tucker (US 4,636,505) or Miller et al (WO 98/55153).

Applicants disagree. Applicants maintain that Miller is disqualified as a reference under 35 U.S.C. 103(a), as the subject matter described in Miller and that claimed in the subject Application were commonly owned at the time the invention of the subject Application was made. Applicants herein submit a statement issued by the attorney of record indicating the common ownership by the University of Tennessee Research Corporation of the subject matter described in Miller et al. and that claimed in the subject Application. Accordingly, Applicants request withdrawal of the rejection.

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Furthermore, the Examiner rejected claims 1-20, 24-31, 35-37, 52-64, 68-75 and 79-8 under 35 U.S.C. § 103(a), as allegedly being rendered obvious in view of Tucker (US 4,636,505).

Applicants disagree. Claims 1, 52, 69, and dependents therefrom, recite *metabolites* of the SARM compounds represented by formulas I, II, III, IV, VII, VIII, IX, X. The metabolites of compounds of formulas I, II, III, IV, VII, VIII, IX, X, are produced as a result of *in-vivo* metabolic processing of the compounds, to yield, *inter-alia*, oxidized, hydrolyzed, and methylated forms of the compounds of formulas I, II, III, IV, VII, VIII, IX, X.

Tucker does not describe an O-bridged SARM substituted with an acetamido group. Tucker neither describes nor provides any foundation for metabolites of such SARMs. The Examiner's contention that such compounds are inherently covered in Tucker is erroneous.

Since the acetamido-substituted-O-bridge SARM is not described by Tucker, there is no inherent disclosure of a metabolite of the same, in particular as Tucker provides no guidance or disclosure for metabolites in general. Accordingly, Applicants request withdrawal of the rejection.

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

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Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,

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